

## **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on September 30, 2005, and the references cited therewith.

Claims 67-78 were pending. Claims 67, 68 and 72 are amended; and Claim 71 is cancelled. No new matter has been added by the foregoing. As a result, Claims 67-70 and 72-78 are now pending in this application.

Applicant respectfully requests reconsideration of the above-identified patent application in view of the following remarks.

### 1. Objections

In the Office Action, the Examiner has objected to the claims and specification based on the use of “means plus function” language in the claims, and the Examiner’s contention that the specification fails to explicitly state what structure, materials, and acts perform the function recited in the claim element. Applicant respectfully traverses the Examiner’s objections on the ground that the specification does in fact define each of the means-plus-function elements in terms of the structures/material/acts that make up that element.

The claims include three means-plus-function elements that require definition within the specification: (i) means for utilizing the fluid to at least a portion of the at least one seal; (ii) means for controllably releasing the fluid from the cavity; and (iii) means for directing released fluid to the region. Each of these elements is discussed in the specification, giving structural clarification to the invention. For example, the means for utilizing the fluid is explained:

First, force is applied to deformable portion 36 of outer shell 30, deforming that portion of outer shell 30 towards and into top surface 50 of pouch assembly 24. Once deformable portion 36 and top surface 50 contact one another, force is transferred into top surface 50, towards bottom surface 52. This force compresses sealed fluid chamber 58, pushing fluid towards inner seal 56 of pouch assembly 24. Fluid ruptures region two 66 of inner seal 56, leaving region one 64

intact. Specifically, region two 66 is ruptured at pinch point 62, ensuring the directed release of the fluid from within sealed fluid chamber 58, out of pouch assembly 24.

(Fig. 1, Specification, Pages 22-23, Lines 21-23, 1-4). Similarly, the means for controllably releasing is explained:

In another preferred embodiment, the control means comprises at least a portion of the seal having a pinch-like configuration.

(Specification, Page 3, lines 21-22). Finally, the means for directing released fluid is explained:

In yet another preferred embodiment, one of the top and bottom surfaces of the fluid reservoir includes means for directing released fluid to a region adjacent the fluid reservoir, wherein the directing means comprises at least one slit in the associated top or bottom surface.

(Specification, Page 3, Lines 13-15).

As can be seen, the specification specifically describes the structure of the means plus function language used in the claims in a clear manner such that one of ordinary skill in the art should be readily able to make and use the present invention. Accordingly, Applicant submits that the Examiner's objection be withdrawn.

Further, as requested in the Office Action, Applicant has updated the status and patent number of the parent application.

## 2. Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected Claim 67 under 35 U.S.C. § 112, as failing to comply with the written description requirement. The Examiner has noted that Claim 67 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, this subject matter is noted as the means for utilizing fluid to rupture at least a portion of the at least one seal; and according to the office action, it was not

disclosed in the parent application 09/960,833 (now issued as Patent No. 6,953,446) or in this present application as originally filed.

Applicant respectfully traverses this assertion. Applicant understands that “to comply with the description requirement of 35 U.S.C. §112, first paragraph ...; all that is required is that the application reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him.” *Forssmann v. Matsuo* 23 U.S.P.Q.2d 1548, 1550 (B.P.A.I. 1992). Applicant further understands that “[i]f a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met”, *In re Alton*, 37 U.S.P.Q.2d 1578, 1584 (Fed. Cir. 1996). “Adequate description under the first paragraph of 35 U.S.C. §112 does not require literal support for the claimed invention ... Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed”, *Ex parte Parks*, 30 U.S.P.Q.2d 1234-1236-37 (B.P.A.I. 1993). “If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.* at 264, 191 U.S.P.Q.2d at 98, *In re Alton*, 37 U.S.P.Q.2d 1578, 1583 (Fed. Cir. 1996).

Applicant respectfully submits that the subject matter as claimed in claim 67 was described in the parent application 09/960,833 (now issued as Patent No. 6,953,446) and in this present application as originally filed. See, Specification, Pages 22-23, Lines 21-23, 1-4. Further, Applicant submits that Figs. 1-11 provide the necessary structure and configuration as

described above with respect to Claim 67. Under 35 U.S.C. §112, first paragraph; “under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112.” *Vas-Cath, Inc. v. Mahurkar*, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991). Accordingly, Figs. 1-11 present a structure and configuration of the utilizing means a person of ordinary skill in the art would have understood.

It is, therefore, disclosed in the specification as originally filed that particular embodiments, the means for utilizing, coupled with the embodiments illustrated in Figs. 1-11, satisfy the description requirement of 35 U.S.C. §112, first paragraph with regards to the subject matter of Claim 67.

The Examiner “bears the initial burden ... of presenting a prima facie case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, that burden is discharged by “presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *Wertheim*, 541 F.2d at 263. Applicant requests that the Examiner provide reasons as to why the description is not sufficient to have conveyed to one having ordinary skill in the art that Applicant had possession of the concept of what is claimed.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

### 3. Claim Rejections – 35 U.S.C. §102

Claims 67-73 and 75-78 were rejected under 35 U.S.C. §102(b) as being anticipated by Brown (U.S. Patent No. 5,377,874) and Ness (U.S. Patent No. 4,258,863). The Office Action states that Brown discloses a sealed fluid chamber having a cavity which is at least partially defined by at least one seal and capable of holding fluid therein, a means for utilizing the fluid

(see figs. 1-13), a means for controllably releasing a liquid (the pressure applied by user or the sphere 18). See abstract, col. 1, lines 9-14, and cols. 4-7. Brown discloses a first and second seal (or a first and second region of attachment) which is at either end of the cavity. Another interpretation of the seal/region is the inside/internal and the outside/external of the seal. The top and bottom surfaces can be considered the upright position or the flat position of the fluid reservoir. The pinch point is considered to be the internal crimp of the seal in the broadest interpretation. The Office Action further stated that Ness discloses a sealed fluid chamber having a cavity and means for utilizing (see fig. 1-18), a means for controllably releasing a liquid and a means for directing the fluid.; See abstract, cols. 2-5. Ness discloses a first a second seal (or a first and second region of attachment) which is at either end of the cavity. Another interpretation of the seal/region is the inside/internal and the outside/external of the seal. Ness disclosed a top and bottom surface and a pinch point at the attachment region.

Claim 67 has been amended to incorporate the substance of Claim 71. Claim 68 has been amended to specify that the region adjacent the fluid reservoir is a release reservoir, which includes at least one slit for directing the flow of fluid (See, e.g., Specification, P. 16, Lines 4-11). As was explained therein, the release reservoir “acts as a valley into which the fluid released from sealed fluid chamber 58 will flow.” (Specification, Page, 16, Lines 10-11). Once in the release reservoir, the at least one slit provides direction for the flow of fluid out of the release reservoir.

Claim 67 and 75 disclose a device and method of using a device that includes a seal with a first region of attachment and a second region of attachment (see, Figs. 1-11), wherein the first region 64 of attachment has a weaker attachment than the second region 66 of attachment. For example, as was explained in the specification, the seal can be formed using conventional

techniques such as heat or pressure welding (Page 14, Lines 5-6), stitching or adhesive, (Page, 14, Line 9), as well as many other types of conventional processes. The device in Claim 67 and the method in Claim 75, therefore, utilize a seal having two regions, one region of which includes a weaker connection than the other region or regions. In doing so, the weaker region is ruptured at pinch point 62.

Neither of these embodiments is disclosed in either Brown or Ness. In fact, neither Brown nor Ness even contemplates a release reservoir having a slit, or a variance in the weld strength of their seals, as disclosed in Claims 67, 68 and 75. Since a rejection under 35 U.S.C. §102(b) requires that the cited reference(s) disclose each and every claim limitation, Applicant asserts that neither Brown nor Ness anticipate Claims 67, 68 and 75. Applicant further submits that dependent claim 69-73 and 76-78 are not anticipated as they contain additional limitations to independent claims 67 and 75. In addition, these dependent claims point to additional aspects or features regarding specific embodiments of Applicant's invention. For these reasons, Applicant submits that claims 67-73 and 75-78 are patentable over Brown or Ness.

Claims 67-68 and 75 are rejected under 35 U.S.C. §102(b) as being anticipated by Higashikawa (U.S. Patent No. 5,830,193). The reasons enumerated above for Claims 67, 68 and 75 apply equally well to the 35 U.S.C. §102(b) rejection of Claims 67-78 and 75. Accordingly, reconsideration and withdrawal of this rejection is also respectfully requested.

For the above-identified reasons, Applicant respectfully requests reconsideration and allowance of Claims 67-73 and 75-78.

#### 4. Claim Rejections Over 35 U.S.C. §103

To establish a *prima facie* case of obviousness, there basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to an art worker, to modify the reference or to combine reference teachings so as to arrive at the claimed invention. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations (MPEP §2143). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure (MPEP citing with favor, *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Applicant submits that a prima facie case of obviousness is not supported.

Claim 74 was rejected under 35 U.S.C. §103(a) as being unpatentable over Brown or Ness. Claim 74, however, depends from the now-allowable Claim 67. Accordingly, Applicant submits that Claim 74 points to additional aspects or features regarding specific embodiments of Applicant's invention. Since a *prima facie* case of obviousness rejection requires that the references cited teach all the claim limitations, Applicant respectfully requests reconsideration and withdrawal of this rejection.

5. Conclusion

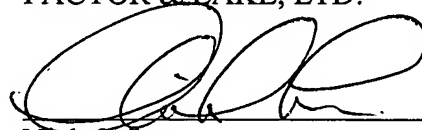
Applicant believes that all pending claims are in condition for allowance. Therefore, reconsideration and passage to allowance of same is respectfully requested.

Should anything further be required, a telephone call to the undersigned at (312) 226-1818 is respectfully solicited.

DATED: December 30, 2005

Respectfully submitted,

FACTOR & LAKE, LTD.

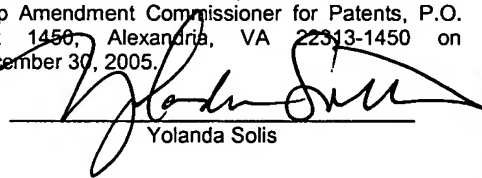


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